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3626
#13/Response
J. Ellis
1-16-04

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Date: December 30, 2003

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PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: POVOLNY et al.

Serial No.: 09/637,138

Filed: August 11, 2000

Title: INTERACTIVE PATIENT-PROVIDER
DATA SYSTEM AND METHOD

Art Unit: 3626

Examiner: Alexander G. Kalinowski

RESPONSE TO REQUIREMENT FOR INFORMATION

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In the Office Action dated November 4, 2003, the Examiner set forth a requirement for information under 37 C.F.R. § 1.105. Applicants respond to this requirement as follows:

The Ortho Sesame product was developed by the assignee, Pt Interactive Inc., based on the invention disclosed in the present application. The Ortho Sesame product, which was the first product to make use of the present invention, was not publicly used until sometime after August 12, 1999. The first publication of anything related to the Ortho Sesame product consisted of an advertisement placed by Pt Interactive in the August 1999 issue of the *Journal of Clinical Orthodontics* (JCO). A photocopy of the page bearing this advertisement and of an information page for the same issue are enclosed. Notably, this advertisement does not mention Ortho Sesame, nor does it disclose any information about the invention. Although the ad invites readers to obtain more information from a website at www.PTInteractive.com, there was no information pertaining to the invention or to the Ortho Sesame product published at that site or anywhere else until sometime after August 12, 1999. JCO mailed the August 1999 issue sometime between the 12th and 15th of August, second class. Therefore, the first advertisement for the Ortho Sesame product would not have been seen by subscribers to JCO until late August.

It is settled law that "[a] magazine is effective as a printed publication under 35 U.S.C. 102(b) as of the date it reached the addressee and not the date it was placed in the mail." M.P.E.P. 706.02(a), citing *Protein Foundation Inc. v. Brenner*, 260 F. Supp. 519 (D.D.C. 1966); M.P.E.P. 2128 (discussing *Carella v. Starlight Archery*, 804 F.2d 135, 139 (Fed. Cir. 1986), which cited *Protein Foundation* and other cases in adopting the rule that a printed publication must be "available and accessible to persons concerned with the art to which the document relates.") Here, the earliest known publication related in any way to the Applicant's Ortho Sesame product was not mailed until at least one day *after* the critical 102(b) bar date of August 11, 1999. Hence, the JCO advertisement cannot constitute prior art under 102(b), being published too late in time. Of course, the JCO advertisement is not prior art under 102(a) either, because it is the applicant's own publication.

The JCO advertisement, while being too late to create any bar under 102(b),

would not raise any bar under 102(b) even if it had been published earlier. 35 U.S.C. § 102(b) requires that the invention be "described in a printed publication" or "in public use or on sale." The JCO advertisement did not describe the invention in any way. It merely invited readers to view a website. Nor could this advertisement constitute an offer to sell. "Only an offer which rises to the level of a commercial offer for sale, one which the other party could make into a binding contract by simple acceptance (assuming consideration) constitutes an offer for sale under § 102(b)." M.P.E.P. 2133.03(b)II, *citing Group One, Ltd. v. Hallmark Cards Inc.*, 254 F.3d 1041, 1048 (Fed. Cir. 2001). Again, the mere invitation to visit a website could not have created a power of acceptance in the reader, and therefore could not have placed the invention "on sale."

Applicants further note that no information concerning the Ortho Sesame product was published at the website until after August 12, 1999. The first public use of the Ortho Sesame product did not occur until some time in October, 1999.

To summarize, Applicants are not aware of any publication disclosing the invention, or of any public use of the invention, or of any offer for sale of the invention, until after August 12, 1999. Because the present application was filed on August 11, 2000, none of these publications, offers, or uses comprise prior art under any section of 35 U.S.C. § 102. Accordingly, none need be disclosed under 35 U.S.C. § 1.97. The Examiner is invited to telephone the undersigned if any further information is required.

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While the Applicants believe that no fees are due in connection with the filing of this paper, the Commissioner is authorized to charge any shortage in the fees, including extension of time fees, to Deposit Account No. 50-0639.

Respectfully submitted,



Date: December 30, 2003

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Enclosure: Excerpted pages from JCO (2 sheets)